

REMARKS

Applicants have carefully considered the June 13, 2008 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-14, 16, 17, 19 and 20 were pending in this application.

In response to the Office Action dated June 13, 2008, claims 16, 17, 19 and 20 have been canceled and claim 11 has been amended. Claims 1, 11, 12 and 13 are the pending independent claims. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

The Examiner is respectfully requested to expressly consider the Information Disclosure Statement submitted on June 4, 2008 and make of record the references cited on the PTO-1449. The Examiner is requested to forward a properly initialed copy of the PTO-1449 with the next Office Action. Moreover, the Examiner is respectfully requested to expressly consider the Information Disclosure Statement submitted on January 26, 2005 and make of record the two U.S. patent documents cited on the PTO-1449. The Examiner is requested to forward a properly initialed copy of the PTO-1449 with the next Office Action.

Claim 1 was rejected under 35 U.S.C. § 102(b) as being unpatentable over Jones et al. (U.S. Pat. No. 6,128,402, hereinafter "Jones I"). Applicants respectfully traverse.

Independent claim 1 recites a banknote handling device comprising, inter alia, a counterfeit processing module that stores each banknote determined as counterfeit into the counterfeit collection box and prohibits the stored counterfeit banknote from being returned to the customer. Claim 1 further requires a notification module that notifies the customer of a predetermined kind of information. The information provided for the customer, in the notification, is indicative of a total amount of money received from the customer and is indicative of an amount of money settled as a transaction; regardless of the result of the counterfeit detection by the discrimination module. Independent claim 1 further specifies that the customer is notified of information for specifying an amount of money in banknotes determined as counterfeit by the discrimination module, out of the total amount of money received from the customer.

Thus, a feature of present claim 1, which is not disclosed or suggested by Jones I, is that the customer is notified of information (via the notification module) for specifying a total amount of money received from the customer, including any received counterfeit banknotes. Contrary to the Examiner's assertion, Jones I does not teach or suggest this limitation. In more concrete terms, Jones I teaches at col. 11, lines 14-21 the following:

Alternatively, at least preferred customers can be given full credit immediately, subject to later verification, or immediate credit can be given up to a certain dollar limit. In the case of counterfeit bills that are not returned to the customer, the customer can be notified of the detection of a counterfeit suspect at the ATM or later by a written notice or personal call, depending upon the preferences of the financial institution.

In the foregoing description from Jones I, the information provided to the customer is the full credit including the counterfeit bills, and a notice of the detection of a counterfeit suspect at the ATM, but there is no teaching or suggestion of providing the customer notification of

information specifying an amount of money in banknotes determined as counterfeit, out of the total amount of money received from the customer.

The above argued difference between the claimed subject matter and the banknote device of Jones I undermines the factual determination that Jones I discloses the banknote handling device identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 86 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Jones I is not factually viable and, hence, solicit withdrawal thereof.

Dependent claims 2 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones I in view of Jones et al. (U.S. Pat. No. 6,843,418, hereinafter “Jones II”). Applicants respectfully traverse.

Dependent claims 2 and 4 are patentably distinct from Jones I for at least their dependency from independent claim 1. The separate patentability of claim 2 is discussed below.

With respect to claim 2, as discussed above with respect to claim 1, Jones I discloses notifying the customer about the full credit including the counterfeit bills, and a notice of the detection of a counterfeit suspect at the ATM, but there is no teaching or suggestion of notifying the customer about information specifying an amount of money in banknotes determined as counterfeit, out of the total amount of money received from the customer, much less, specifying the type and number of the banknotes determined as counterfeit by the discrimination module, as required in claim 2.

With respect to Jones II, the patent discloses, at col. 31, lines 36-37 and col. 32, lines 1-6, that twelve pieces of information are displayed. In more concrete terms, Jones II teaches displaying the total amount of authentic currency bills processed (e.g., \$15,567), but it does not teach or remotely suggest displaying or notifying the customer with information specifying an amount of money in banknotes determined as counterfeit, out of the total amount of money received from the customer.

Jones II also teaches displaying the total number of flagged currency bills processed, but the term “flagged currency bills” means “no call bills” which are unidentifiable bills and suspect bills, and the patent does not teach or suggest displaying or notifying the customer of information specifying the type and number of the banknotes determined as counterfeit. Thus, neither Jones I or II teaches or suggest the display function of claim 2.

Moreover, Jones II teaches, at col. 17, lines 44-49, that the suspect bills are transported to the second upper output receptacle 208b, and the operator/customer is able to easily see the documents in the receptacles 208a-b. The receptacles 208a-b are protruded outside from the apparatus as shown in Figs. 2 and 3. This clearly means that in Jones II, the suspect bills are returned to the customer, and the number of these returned bills are displayed or notified to the customer.

Thus, even if the patents are combined as suggested by the Examiner, the subject matter of claim 2 would not result. Further, it is noted that Jones II returns the suspect bills to the customer which is in direct contrast to Jones I, since Jones I does not return the suspect bills to the customer. Therefore, there is no apparent motivation to combine these references to construct the present claimed subject matter.

Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiroki et al. (U.S. Pat. No. 5,313,050, hereinafter “Hiroki”) in view of Jones I and further in view of Jones II. Applicants respectfully traverse.

Independent claim 11 recites a banknote handling device comprising, inter alia, a counterfeit processing module that stores each banknote determined as counterfeit into the counterfeit collection box and prohibits the stored counterfeit banknote from being returned to the customer. Claim 11 further requires a notification module that notifies the customer of predetermined kind of information. The information provided for the customer, in the notification, is indicative of a total amount of money received from the customer and is indicative of an amount of money settled as a transaction; regardless of the result of the counterfeit detection by the discrimination module. Independent claim 11 has been further amended to specify that the customer is notified of information for specifying an amount of money in banknotes determined as counterfeit by the discrimination module, out of the total amount of money received from the customer.

Thus, a feature of present claim 11 which is not disclosed or suggested by Hiroki, Jones I, or Jones II is that the customer is notified of information (by the notification module) for specifying a total amount of money received from the customer, including any received counterfeit banknotes. The Examiner admitted that Hiroki and Jones I fail to disclose “a notification module that presents currency type and total information to a user”. Applicants submit that Jones II does not teach or remotely suggest displaying or notifying the customer with information specifying an amount of money in banknotes determined as counterfeit, out of the total amount of money received from the customer. Moreover, Jones II teaches displaying the total number of flagged currency bills processed, but the term “flagged currency bills” means

“no call bills” which are unidentifiable bills and suspect bills (e.g. counterfeit) and, therefore, the patent does not teach or suggest displaying or notifying the customer of the amount of counterfeit money out of the total amount of money received from the customer. Thus, even if combined, the references fails to disclose or suggest every limitation of claim 11 and therefore, the rejection should be withdrawn.

As to Claim 12, the Examiner fails to establish that the feature of claim 12, “the management modules maps each counterfeit banknote to customer information of the customer” (emphasis added), is taught by Jones I, Jones II or Hiroki. The Examiner failed to address this express limitation in the rejection. Thus, the rejection is not legally viable for at least this reason.

Moreover, Jones I teaches, at col. 11, lines 14-21, “in the case of counterfeit bills that are not returned to the customer, the customer can be notified of the detection of a counterfeit suspect at the ATM or later by a written notice or personal call.” This portion merely states that the customer is only notified of the detection of a counterfeit suspect at the ATM, but it does not teach or suggest executing a management module to map each counterfeit banknote to customer information of the customer, as required in claim 12. With claim 12, since each counterfeit banknote is mapped to customer information of the customer, it is possible to identify the customer from each counterfeit banknote. Thus, even if combined, the references fails to disclose or suggest every limitation of claim 12 and therefore, the rejection should be withdrawn.

Claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones I in view of Jones II. Applicants respectfully traverse.

The Examiner admitted that Jones I does not disclose partition sheets, but nevertheless relied on Jones II in an attempt to remedy this deficiency. The Examiner asserts that Claims 13 and 14 are obvious from Jones I and Jones II, since Jones II teaches, at Fig. 1d and col. 12, lines

51-67, that the banknotes are bundled and separated by partition sheets 150 that are dispensed from a stacker.

However, Jones II only teaches (Fig. 1d and col. 12, lines 51-67) that the batch identification card 150 is placed at the front end of the documents to be transported, such as the currency bills 154 or barcode tickets 156. The patent does not teach or suggest that all the banknotes, including both genuine and counterfeit banknotes, are stored in the counterfeit collection box. Moreover, the patent does not teach or suggest that a bundle of banknotes is parted from bundles of banknotes received from other customers by partition sheets in the counterfeit collection box storing these mixed banknotes, as required in claim 13. Thus, even if combined, the rejection is not legally viable since not all the limitations of claim 13 are taught by the combination of Jones I and Jones II.

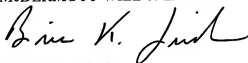
Claims 16, 17, 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiroki in view of Katou et al. (U.S. Pat. No. 6,474,549, hereinafter “Katou”) and further in view of Jones I. Applicants respectfully submit that the rejection is moot in view of the cancellation of claims 16, 17, 19 and 20.

It is believed that the pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner’s amendment, the Examiner is invited to call Applicants’ representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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